



PATENT

Attorney Docket No. MTI-31041-A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Ping, et al.
Serial No. : 10/046,497
Filing Date : October 26, 2001
For : Method For Forming Raised Structures by Controlled Selective Epitaxial Growth of Facet Using Spacer
Group Art Unit : 2814
Examiner : LE, Thao X.
Confirmation No. : 8624

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231 as "Express Mail Post Office to Addressee" Mailing Label No. EV405077753.

Date: Dec 18 2003

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

RESPONSE

Sir:

Applicant requests consideration of the pending claims in the above-identified patent application based on the remarks herein.

Response to Restriction begins on page 2 of this paper.

Remarks begin on page 4 of this paper.

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Response to Restriction Requirement.

In response to the Examiner's requirement for an election of the claims, mailed November 18, 2003, in the above-identified patent application, Applicant elects **GROUP I** with claims directed to a semiconductor device, **Species "c"**, with traverse.

First, the Examiner stated that the inventions of Group I and II are distinct for the following reasons:

Inventions Group I and Group II are related as **process of making** and **process of using** the product. The **use claimed** cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said **method of making** and **method of using**. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

The Examiner statement is in error. Neither Group I nor II are directed to a process of making a product or a process of using a product.

Group I (claims 101-116, 123-202) are **product claims**, drawn to **semiconductor devices**. Group II (claims 203-223) are **product by process claims**, drawn to semiconductor structures.

The invention defined in a product-by-process claim is a **product** — not a process. *In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966). It is the patentability of the **product** claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 541 F.2d, 191 USPQ (CCPA 1976). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Rlug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). However, to the extent that the process limitations distinguish the product over the prior art, they must be given the same consideration and weight in assessing the differences between the claimed subject matter and the prior art. *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 523 (1973).

In addition, the Examiner erroneously identified Group II product-by-process claims under Class 438 for Semiconductor Device Manufacturing: Process. This class provides for manufacturing a semiconductor. The present claims are defined as products — not processes.

The Examiner's reasoning for separation of the pending product claims into the two groups is in error. Accordingly, withdrawal of the requirement for restriction of the claims into Group I and Group II is respectfully requested.

In the event that the Examiner maintains the restriction of Groups I and II, the Examiner is respectfully requested to review and revise the claims identified in Species Groups a-c, as follows:

Species Group	Claims listed by Examiner		Requested Revised Groupings
"a"	101-116, 123-128, 194, 195	transistor with S/D adjacent the gate	101-116, 123-128, 194, 195
"b"	129-142, 156-166	transistor with S/D at top and bottom of gate	161-164
"c"	143-155, 167-193, 196-202	semiconductor structure with at least two epitaxial silicon layers	129-142, 143-155, 156-160, 167-193, 196-202

It is noted that all of the claims require *at least two overlying epitaxial silicon layers*.

Combination/subcombination. At page 3 (§ 4) of the Office Action, the Examiner states that "*Inventions Group a, b and c are related as combination and subcombination.*"

A clear explanation of the basis for this assertion is requested. It is unclear what the Examiner has identified as the "combination" and as the "subcombination." Consequently, Applicant is unable to properly respond to the Examiner's statement.

The Examiner stated that:

...it is evidence [sic] that the semiconductor structure having at least two epitaxial silicon layers is patentable by itself. In addition, the subcombination has separate utility such as but not limited to S/D region, a conductor, or gate conductor.

It is unclear as to what the purported "combination" and "subcombination" are with respect to the claims. The claims are directed to semiconductor structures which can be, for example, a transistor gate structure, a source/drain structure, etc. It is again noted that all of the claims require *at least two overlying epitaxial silicon layers*.

Clarification is requested to enable the Applicant to respond.

Remarks

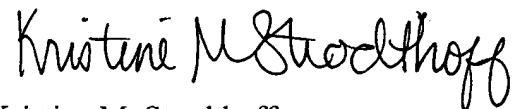
Information Disclosure Statement. The Examiner is requested to return a copy of the Form 1449/PTO which was submitted in a Supplemental Information Disclosure Statement, in the RCE filed September 10, 2003. A copy of this submission is enclosed herewith. (The references are not included. Applicant will send another copy if needed.)

Return of the Form 1449/PTO is requested showing the references as being initialed and considered.

Extension of Term. The proceedings herein are for a patent application and the provisions of 37 CFR § 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition for extension of time. If any extension and/or fee are required, please charge Account No. 23-2053.

It is submitted that the present claims are in condition for allowance, and notification to that effect is respectfully requested.

Respectfully submitted,



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Dated: December 18, 2003

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